

### **AMENDMENTS TO THE DRAWINGS**

The attached "Replacement Sheet" of drawings includes changes to Figures 2 and 5. The attached "Replacement Sheets," which include Figures 2 and 5, replace the original sheets including Figures 2 and 5

Attachment: Replacement Sheets

## **REMARKS**

Applicants have amended Figures 2, 5, claims 1, 2, 7-11, 20 and 24. Claims 12-14 were previously cancelled and claim 25 has been added. Claims 1-11 and 15-25 are currently pending. Reconsideration of the present application is requested.

### **INFORMATION DISCLOSURE STATEMENT**

Applicants appreciate the Examiner's consideration of all references provided along with the Information Disclosure Statement filed December 7, 2004.

### **DRAWING OBJECTIONS**

Applicants have amended the drawings, taking into account the comments made by the Examiner. Withdrawal of this objection is requested. Support for the amendments made to the drawings may be found, for example, in paragraph [0068] on page 4 of Applicants' Specification.

### **CLAIM OBJECTIONS**

Applicants have amended claims 2, 7, 9-11, 20 and 24 taking into account the comments made by the Examiner. Withdrawal of these objections is requested.

### **PRIOR ART REJECTIONS**

#### **I. REJECTION OF CLAIMS 1 AND 4-9 UNDER 35 U.S.C. § 103(A) IN VIEW OF USP 6,505,966 ("GURU") AND USP 5,220,589 ("GARD").**

The Examiner rejects claims 1 and 4-9 as allegedly being unpatentable over U.S. Patent No. 6,505,966 ("Guru") in view of U.S. Patent No. 5,220,589

("Gard"). In particular, the Examiner correctly recognizes that Guru fails to teach or suggest all features set forth in claims 1 and 4-9, and relies upon Gard to make up for these deficiencies.<sup>1</sup> This rejection is respectfully traversed.

**A. THE REJECTION OF CLAIMS 1 AND 4-9 SHOULD BE WITHDRAWN BECAUSE A PRIMA FACIE CASE OF OBVIOUSNESS FOR COMBINING GURU AND GARD HAS NOT BEEN ESTABLISHED.**

**1. A PRIMA FACIE CASE OF OBVIOUSNESS HAS NOT BEEN ESTABLISHED BECAUSE THE EXAMINER HAS FAILED TO PROVIDE THE REQUISITE MOTIVATION FOR COMBINING GURU AND GARD.**

The above rejection should be withdrawn because the Examiner has failed to establish a *prima facie* case of obviousness for rejecting claims 1 and 4-9. To establish a *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to the skilled artisan, to modify a reference or combined reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art references when combined must teach or suggest all features of the claim.<sup>2</sup> Failure to meet any or all of the above criteria results in failure to establish a *prima facie* case of obviousness and the rejection should be withdrawn. The Examiner has failed to provide the requisite motivation for combining Guru and Gard, and therefore, has failed to establish a *prima facie* case of obviousness for rejecting claims 1 and 4-9.

The Examiner alleges that combining the teachings of Gard with the teachings of Guru would, "allow the scanner [presumably of Guru] to

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<sup>1</sup> Current Office Action, pp. 4-5.

<sup>2</sup> See M.P.E.P. § 706.02(j)

compensate for offset."<sup>3</sup> However, the Examiner has failed to provide the evidence of the requisite motivation, suggestion, or teaching of the desirability of making the specific combination.<sup>4</sup> Instead, the Examiner has made a broad and conclusory statement that the combination would allow for compensation of offset. This conclusory statement is insufficient because the Examiner has not provided any evidence in support thereof. Therefore, the rejection should be withdrawn because the Examiner has failed to provide the requisite motivation, suggestion or teaching to combine Guru and Gard to arrive at the claimed invention as set forth in claims 1 or 4-9.

**B. THE REJECTION OF CLAIMS 1 AND 4-9 SHOULD BE WITHDRAWN BECAUSE GARD TEACHES AWAY FROM CLAIM 1.**

The Examiner relies upon column 1, lines 60-63 of Gard in asserting that Gard teaches collecting data when the x-ray beam is off. However, the Examiner fails to take into account that the entire context of Gard in determining whether the combination of Guru and Gard would be obvious to one of ordinary skill in the relevant art. Gard is directed to performing error correction based on data recorded when the x-ray beam is on.<sup>5</sup> In fact, Gard states that an error correction based on data collected without incident x-ray radiation is disadvantageous, and such data collection is not suitable for performing proper error correction. To the contrary, Gard attempts to improve error correction by performing error correction based on data recorded when

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<sup>3</sup> Current Office Action, pp. 6.

<sup>4</sup> In re Dembiczak, 50 USPQ2d 1614 (Fed.Cir. 1999)

<sup>5</sup> Gard, col. 5, ll. 44-47.

the x-ray beam is on.<sup>6</sup> Therefore, Gard teaches away from performing error correction based on data recorded without incident x-ray radiation, contrary to claim 1. Because Gard explicitly discusses the disadvantage of performing error correction based on data collection when the x-ray beam is off, the skilled artisan would not look to Gard for the deficiencies of Guru with respect to claim 1. Therefore, the device of claim 1 is not obvious over the combination of Guru and Gard.

**II. REJECTION OF CLAIMS 2, 15-16 AND 18-23 UNDER 35 U.S.C. § 103(A) IN VIEW OF USP 6,505,966 ("GURU") AND USP 5,786,994 ("FRIZ").**

The Examiner rejects claims 2, 15-16 and 18-23 under 35 U.S.C. § 103 as allegedly being unpatentable over Guru in view of Friz. This rejection is respectfully traversed.

**A. THE REJECTION OF CLAIMS 2, 15-16 AND 18-23 SHOULD BE WITHDRAWN BECAUSE NEITHER GURU NOR FRIZ, TAKEN SINGLY OR IN COMBINATION, TEACH AT LEAST, THE "EVALUATION DEVICE," OF CLAIM 2.**

The Examiner relies upon the system performance computer 10 of Guru to allegedly teach the "evaluation device," of claim 2. More particularly, the Examiner relies upon step 120 of FIG. 5 to teach, "at least one of the drive and setting of the X-ray beam source is automatically changed between the at least two measurements," as recited in claim 2. Applicants disagree.

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<sup>6</sup> Gard, col. 3, ll. 5-8.

**1. THE REJECTION SHOULD BE WITHDRAWN BECAUSE STEP 120 IN FIG. 5 OF GURU DOES NOT CONSTITUTE, "AT LEAST ONE OF THE DRIVE AND SETTING OF THE X-RAY BEAM SOURCE IS AUTOMATICALLY CHANGED BETWEEN THE AT LEAST TWO MEASUREMENTS," AS RECITED IN CLAIM 2 AND FRIZ FAILS TO MAKE UP FOR THE DEFICIENCIES OF GURU.**

The evaluation device of claim 2 performs at least two measurements, and at least one of the drive and setting of the x-ray beam source is automatically changed. Raw data obtained from these measurements may then be used to calculate at least one parameter, and the evaluation result may be displayed. By changing the driver's setting of the x-ray source it may be possible to assess several quality parameters within a single evaluation procedure. Several, consecutive independent evaluations need not be performed.

Guru teaches setting measurement parameters (step 120 of FIG. 5), conducting measurements (step 122 of FIG. 5) and assessing quality parameters.<sup>7</sup> Contrary to the device of claim 2, however, Guru fails to teach at least one of the drive and setting of the x-ray beam source being automatically changed. In Guru, while the drive and setting may arguably be changed, the drive and/or setting are not automatically changed between at least two measurements used in gathering the raw data used in calculating at least one value of at least one parameter. That is, in Guru, the drive and/or setting are changed between measurements used in gathering raw data for the same calculation. To the contrary, the parameters in Guru are set prior to the collection of data, and not changed until after calculations are made.

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<sup>7</sup> Guru, col. 5, ll. 5-20 and Fig. 5.

Moreover, if an abnormality is detected in Guru, further validation processes must be performed to assess the nature of the abnormality.<sup>8</sup> This results in a lengthened validation process, which is in direct contrast to the device of claim 2 directed to reducing processing time.

The Examiner acknowledges that Guru fails to teach "initiating at least two measurements for production of raw data," as recited in claim 2, and relies upon Friz to allegedly teach this feature. However, Friz suffers from the same deficiencies as Guru in that at least one of the drive and setting of the X-ray beam source are not automatically changed between the at least two measurements in Friz. Therefore, even assuming *arguendo* that Guru could be combined with Friz (which Applicants do not admit), the combination fails to render claim 2 obvious. Because claim 2 is not obvious over the Examiner's alleged combination of Guru and Friz, withdrawal of this rejection is requested.

**III. REJECTION OF CLAIMS 10 AND 17 UNDER 35 U.S.C. § 103(A) IN VIEW OF USP 6,505,966 ("GURU"), USP 5,220,589 ("GARD") AND USP 5,786,994 ("FRIZ"); CLAIM 11 UNDER 35 U.S.C. § 103(A) IN VIEW OF GURU, GARD AND USP 6,327,330 ("PETER"); AND CLAIMS 3 AND 24 UNDER 35 U.S.C. § 103(A) IN VIEW OF GURU, FRIZ AND PETER.**

Under 35 U.S.C. § 103(a), the Examiner further rejects claims 10 and 17 over Guru, Gard and Friz; claim 11 over Guru, Gard and Peter; and claims 3 and 24 over Guru, Friz and Peter. This rejection is traversed. The Examiner correctly recognizes that Guru and Gard fail to teach at least some features set forth in claims 10 or 17, and relies upon Friz to allegedly teach these features. However, even assuming that Guru, Gard and/or Friz could be combined, no

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<sup>8</sup> *Id.* at col. 5, ll. 42-44 and Fig. 5 ("periodic service checks 108 of the system...performed by service technicians")

combination of these references renders claims 10 or 17 obvious for at least the reasons discussed above with regard to claims 1 or 2.

Moreover, the Examiner correctly recognizes that Guru, Gard and/or Friz fail to teach at least some features set forth in claims 3, 11 or 24, and relies upon Peter to allegedly teach these features. However, even assuming that Guru, Gard, Friz and/or Peter could be combined, no combination of these references renders claims 3, 11 or 24 obvious for at least the reasons discussed above with regard to claims 1 or 2. Therefore, withdrawal of these rejections is requested because no combination of Guru, Gard, Friz and/or Peter renders claims 3, 10, 11, 17 or 24 obvious.

### **CONCLUSION**

In view of above remarks, reconsideration of the outstanding rejection and allowance of the pending claims is respectfully requested.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Andrew M. Waxman, Reg. No. 56,007, at the number of the undersigned listed below.




If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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